Remarks

Claims 1 through 39 are pending in the application. By the Office Action dated May 5, 2005, the Patent Office has rejected Claims 1-39. By this amendment and response, Applicants have amended Claims 1 and 28.

Claim Amendments

Claim 1 has been amended to delete the alleged offending claim language. Specifically, rather than recite that the susceptor is "capable of absorbing electromagnetic energy", Applicants have merely defined the susceptor layer as being "an electromagnetic energy absorbing susceptor layer."

Claim 28 has been amended to more clearly define the limitation of the claim, denoting the correlation between the absorption of electromagnetic energy and the generation of heat. No new matter is entered as this relationship is inherent from the original wording of the claim and is clearly supported by the whole of the specification.

Claims Rejections - §112

Claims 1-28 stand rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Specifically, relying upon the holding of In re Hutchison, 69 USPQ 138, it is alleged that Applicants' use of the term "capable of" is indefinite as it merely sets forth an ability to perform and does not constitute a limitation in any patentable sense. In light of the amendment of Claim 1, this rejection insofar as Claims 1-27 is concerned is now moot and should be withdrawn. As to the application of this rejection to Claim 28, Applicants respectfully traverse the rejection and request reconsideration.

Contrary to the apparent assertion of the Patent Office, In re Hutchison does not create a *per se* rule against the use of terms like "capable of", "adapted to", etc.; rather their use and meaning must be considered in light of the claim language and the specification so as to ascertain whether such language establishes a positive, negative, or functional limitation which provides definiteness to the claim. See e.g., In Re Venezia, 530 F. 2d 956 (1976) and Ex Parte Kirk D. Prall, Appeal No. 2003-1556, an unpublished opinion of the Board of Patent Appeals and Interferences. Furthermore, as more clearly set forth in MPEP §2173.05(g), the use of such terms in conjunction with defined properties, characteristics, etc. interjects a functional limitation

to a claim which functional claim language is fully consistent with patent practice. Indeed, the MPEP specifically states: "[A] functional limitation is often used in association with an element,...to define a particular **capability** or purpose that is served by the recited element..." (Emphasis added)

In light of the foregoing discussion, Applicants' use of the phrase "capable of generating sufficient heat upon exposure to suitable electromagnetic energy to melt an adhesive material" in Claim 28 is clearly a positive and functional limitation. Thus, the rejection of Claim 28 under 35 USC §112, second paragraph, as being indefinite, is inappropriate and should be withdrawn.

Double Patenting Rejection

Claims 1-39 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of co-pending Application No. 10/449,209. The Patent Office states that although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one skilled in the art to modify the laminates and methods of the present application to include tapes, bonding tapes and bonding systems as in the co-pending application since both comprise a susceptor layer being capable of absorbing electromagnetic energy as an inventive feature. Applicants respectfully traverse the provisional rejection and request reconsideration.

As set forth in MPEP 804(B)(1), the first step in determining whether a basis exists for a non-statutory double patenting rejection is to ask, "does any claim in the application define an invention that is merely an obvious variation of any invention claimed in the patent?" The claims of the present application all relate to high-pressure laminates and methods of making and using the same wherein one element of the high-pressure laminate structure is an electromagnetic absorbing susceptor element. As recited in Claim 1, the structure comprises a decorative layer, core layer and an electromagnetic energy absorbing susceptor layer. The claims of the co-pending patent application all relate to multi-layer bonding or seaming tapes that comprise a base layer, a susceptor layer and an adhesive layer. Though there is a common element, the susceptor layer, and the possibility exists that the high-pressure laminate may also have a pre-applied adhesive layer attached to the high-pressure laminate, they are not the same or even similar inventions. High-pressure laminates and bonding or seaming tapes are not the same or similar articles of manufacture and certainly not obvious variations of one another. Even the Patent

Office has recognized this in its statement that one could "modify the laminates and methods of SN 10630270 to include tapes, bonding tapes and bonding systems as in SN10449209...." The inventions defined by each set of claims cannot represent obvious variations of one another if one is merely an element that could be used in the manufacture or method of the other. If such were so, two set of claims in co-pending applications, one to a new computer chip and another to a satellite incorporating that chip would represent a provisional double patenting situation, which clearly it does not.

It is clear that the Patent Office has not established the basis for a provisional double patenting rejection and, indeed, no such circumstance is presented between the instant application and co-pending application SN 10/449,209. Consequently the rejection should be withdrawn and the application passed on to allowance.

Summary

In light of the foregoing amendments and discussion, Applicants have fully addressed and/or rebutted the bases for each of the rejections set forth in the Office Action. Applicants believe the claims, as now presented, are in allowable form and hereby respectfully request that the application be passed on to allowance.

Fees

No fees are necessary as this response is being filed prior to the expiration of the three month shortened statutory period for response and the number of independent and total claims remaining is less than originally filed.

Respectfully submitted,

Edward K. Welch II
Attorney for Applicants
Reg. No. 30,899
c/o Frost Brown Todd LLC
2200 PNC Center
201 East Fifth Street
Cincinnati, OH 45202-4182
Tel.: 781-718-9512
e-mail: welched@comcast.net